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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671
22440	7590	01/30/2004	EXAMINER FLYNN, KIMBERLY D	
GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 100160601			ART UNIT 2153	PAPER NUMBER 124

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/385,802

Applicant(s)

BARTHOLOMEN DONOVAN,
KEVIN REMINGTON JOS

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to an Amendment filed November 12, 2003. Claims 1-8, 10-20, and 22-24 are presented for further consideration.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-8, 10-20, and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Auerbach (U.S. Patent NO. 6,549,937 hereinafter Auerbach).

In considering claim 1 and 24, Auerbach discloses a distributed communication system in which a plurality of users associated with different realms access the Internet via a corresponding PC through a service provider, a device for providing instant messaging between the users, the device comprising:

an IM manager associated with the PC of a first user and arranges to obtain a foreign protocol for communicating with another realm (col. 7, lines 10-17); and

an IM server including an IM database with a listing of users currently connected to the Internet, each having a unique identifier (col. 6, lines 14-28);

the IM manager being further arranged to receive the unique identifier of a particular user associated with the another realm from the IM server and to establish

connection to the other user using a foreign protocol (col. 10. lines 48-51, and lines 56-64 see also col. 11, lines 32-38).

In considering claim 2, Auerbach discloses wherein a local database is arranged to store a plurality of foreign protocols, each protocol being associated with a corresponding different realm *(The database containing a plurality of foreign protocols being associated with different realms is an inherent feature of the conversion platform (112) and the protocol services modules which provide a conversion between the different protocols of the different service providers to allow a client application to communicate with servers of multiple service providers)*

In considering claim 3, Auerbach discloses wherein the IM server is arranged and constructed to connect to the Internet and to receive and transmit information to and from the IM manager via the Internet (col. 6. lines 65-67 through col. 7, lines 1-17).

In considering claims 4, Auerbach discloses wherein the IM database is arranged to store information related to all users (col. 6, lines 21-28).

In considering claim 5, Auerbach discloses a display arranged to show a list of current friends of a user and a selector operated by the user to select a friend from the list to establish communication (col. 6, lines 8-13 and lines 29-42).

In considering claim 7, Auerbach discloses wherein the users are arranged to communicate over the Internet by different SPs wherein the IM database is incorporated into one of the SPs (col. 4, lines 51-58).

In considering claim 8, Auerbach discloses an IM service provider wherein the IM database is incorporated into the IM service provider (col. 5, lines 49-53).

In considering claim 10 and 22, Auerbach discloses wherein each of the first and second devices is arranged to display a window on the screen, the window identifying a list of friends of the corresponding user, the friends being currently on line (col. 6, lines 8-10).

In considering claim 12, Auerbach discloses wherein each of the devices is adapted to receive commands from the respective user to establish a first IM session between the first user and the second user and a second IM session between the first user and a third user, the third user being identified in the window (col. 8, lines 61-66).

In considering claim 15, Auerbach discloses wherein the first device is adapted to show characteristics of the friends (col. 11, lines 4-12).

In considering claims 6 and 16, the claims include limitations that are inherent of instant messaging systems and limitations that are substantially the same as claims 1 and 24; therefore the same grounds of rejection are applicable.

In considering claim 11, Auerbach discloses wherein the first device is adapted to display a message area in one of the windows and a separate window *(The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach).*

In considering claim 13, Auerbach discloses wherein the first device is adapted to allow the first user to switch between the first IM session and the second IM session, the first and second IM session being active simultaneously *(The aforementioned limitations*

are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach).

In considering claim 14, Auerbach discloses wherein the first device is adapted to display in the message area messages with the second user during the first IM session and messages with the third user during the second IM session *(The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach).*

In considering claim 17, Auerbach discloses wherein each time one of the first and second users access the Internet, the corresponding device sends a message to an IM database indicating the corresponding user is online and the current IP address *(The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach).*

In considering claim 18, Auerbach discloses wherein the step of determining the current IP address comprises retrieving the address from the IM database *(The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach).*

In considering claim 19, Auerbach discloses sending a connection request from the first to the second device for establishing the instant message session (*The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach*).

In considering claim 20, Auerbach discloses generating a response to the connection request by the second device accepting the connection request (*The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach*).

In considering claim 23, Auerbach discloses displaying the window with a message area the message area being used to indicate messages between users (*The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication as disclosed by Auerbach*).

Response to Arguments

4. Applicant's arguments with respect to claims 1-8, 10-20, and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

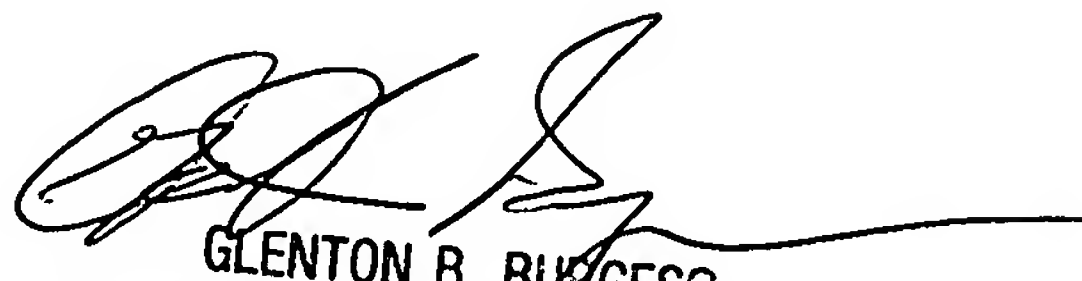
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Kimberly D Flynn
Examiner
Art Unit 2153

KF
January 26, 2004


GLENTON B. BURGESS
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